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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/545,336 | 04/07/2000 | David M. Tumey | 06.2916.004 | 9586 |

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EXAMINER

HESELDTINE, RYAN J

| ART UNIT | PAPER NUMBER |
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2623

DATE MAILED: 05/12/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/545,336

Applicant(s)

TUMEY ET AL.

Examiner

Ryan J Hesseltine

Art Unit

2623

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. 112, second paragraph rejection of claim 10.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-11.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO 1449) Paper No(s). _____
10. ☐ Other: _____

JINGGEWU
PRIMARY EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: On page 6, third paragraph, applicant states, "Claims 1 and 2 separate the physical structure used to capture the image from the physical structure used to analyze the image representation to recognize the individual. A portable smart card is used to capture the image. A central processor housed in a separate structure is used to recognize the image." The examiner respectfully disagrees. First, the examiner would like to point out that neither claim 1 nor claim 2 state that the smart card is portable, that the central processor is housed in a separate structure, or that the physical structure used to capture the image is separate from the physical structure used to analyze the image representation to recognize the individual. The examiner would like to point out that the term "central processor" is a generic term well-known in the art such as a central processing unit (CPU) in a computer system and does not necessarily mean a physically separate structure. Also note that neither claim 1 nor claim 2 state that the central processor is within the docking port for receiving said smart card. Finally, the examiner would like to point out that even if such a limitation were added to the claims, the examiner does not feel such a limitation would render the claims non-obvious. There are any number of references that perform recognition at a remote location such as a central database. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a central processor housed in a separate structure") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

On page 6, fifth paragraph, applicant states, "To date, no evidence has been presented of any motivation to combine Morinaga with Wang in a manner that would keep the two structures separate." The examiner respectfully disagrees. See the above response for discussion of keeping the smart card and central processor separate. With respect to the combination of Morinaga in view of Wang, the only deficiencies in Morinaga and relied upon in Wang are a digitizer integrated within said smart card for digitizing facial image data and that the portable electronic information device is used as a non-invasive human user identification and verification system. The first limitation, a digitizer for digitizing facial image data is inherently present in Wang and is extremely well known in the art of digital cameras and facial recognition. The second limitation is briefly mentioned in Morinaga when it is disclosed that a card-shaped information medium is provided with a memory, which can be used for information processing (column 1, line 19-27), and that an image can be photographed using an electronic camera provided at the card-shaped information medium, and an address table with face pictures can be prepared by combining the photographed images and an address table (column 5, line 38-43). Wang is merely relied upon to show the conventional digital camera and that a portable device can be used to assist a user in recognizing people and retrieve personal-identifying information from a database in accordance with an input face image (column 2, line 18-31). The examiner was not intending to suggest that modifying Morinaga in view of Wang would make Morinaga more portable, personal, and easy to use, but that the modification would provide such a device able to process and/or recognize facial images. In response to applicant's argument that there is no motivation to combine Morinaga with Wang, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

On page 8, third paragraph, applicant states, "Claim 3 requires that biometric information be captured by a sensor on the card but that authentication be done remotely, by another processor, away from the smart card." The examiner respectfully disagrees. While claim 3 states that the communications port is external to the personal identification device, there is no limitation that states that "authentication be done remotely, by another processor, away from the smart card." See the first paragraph above for discussion of keeping the smart card and central processor separate. In the same paragraph, applicant states, "The first-noted object and very title of Lane, 'Self-Authenticating Identification Card With Fingerprint Identification,' teaches away from this aspect of the claimed invention:". The examiner respectfully disagrees. The examiner realizes that perhaps Lane's preferred embodiment includes an authenticator with the identification (ID) card that compares information related to a sensed fingerprint with stored fingerprint information, but the examiner believes the proposed modification is not taught away from and does not render the invention inoperable. Applicant cited column 1-2 of Lane, which is part of a sentence that starts on line 67 of column 1, which states, "Separate scanners, and the knowledge to operate them, dramatically increase the costs and complexity associated with an identification card system." This is Lane's motivation for including the fingerprint scanner with the ID card, but this does not necessarily mean that the fingerprint comparison could not be performed separately from the ID card, for example, in the card reader, etc.

On page 8, second to last paragraph, applicant states, "One of Lane's greatest apparent benefits is that banks could issue Lane's credit cards without waiting for stores to upgrade their own card-reading equipment. See Col. 9, line 35 - col. 10, line 3." The cited portion talks about how the ID card is initialized when a person first receives the card and how it is subsequently authenticated with the use of different colored LEDs, but there is no mention that banks could issue credit cards "without waiting for stores to upgrade their own card-reading equipment" as stated by applicant. The examiner believes that the main goal of Lane's preferred embodiment is to incorporate the biometric sensor with the ID card in order to increase security, but the location of the verification processing is inconsequential. Note also that Lane's claim 1 in column 10 recites that the fingerprint sensing means, memory, and controller are all carried by or internal to the substrate of the identification card, but there is no limitation that the authentication means for comparing information is carried by or internal to the substrate. The examiner would also like to point out that applicant has not mentioned any particular advantage to performing the verification separately from the portable personal identification device (smart card).